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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,076	06/08/2006	Kazutaka Kubota	F-9138	1483
28107 7590 01/20/2010 JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168				
EXAMINER				
JONES, MARCUS D				
ART UNIT		PAPER NUMBER		
3714				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/582,076

**Applicant(s)**

KUBOTA ET AL.

**Examiner**

Marcus D. Jones

**Art Unit**

3714

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 10 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10, and 12-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed 5 October 2009 in response to the previous Non-Final Office Action (4 June 2009) is acknowledged and has been entered.

Claims 1-7, 10 and 12-16 are currently pending.

Claims 8,9,11 and 17-19 are cancelled.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-3, 5-7, 10, and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jokipii et al. (US PGPub 2003/0190960), and Donn (US PGPub 2002/0015936), and further in view of Walker et al. (US PGPub 2004/0162130).

In reference to claims 1, 12, and 13, Jokipii discloses a client-side comprising a computing device with connectivity to the Internet or other communications network. The online game system pushes a game client to the user's computer device via the network to provide functionality to play the selected online games (pg 1, par 9). Jokipii further discloses at least two types of tournament pairing systems, manual and automatic (pg 4, par 37). Jokipii also discloses an online gaming system comprising a web server for providing web pages to the viewers and players, a league administration server for enable the creation and management of leagues for playing online game, a game room server, for creating and monitoring/tracking game rooms and maintaining the game state and a tournament server. The online gaming system also includes a ratings server for tracking the results of games played by or between the users and assigning ratings or rankings to the players (pg 2, par 27). Jokipii discloses that the tournament engine permits the league administrator to customize the length of each round. Rounds are considered complete when all the schedule games are complete or a tie for each round expires. When games are unfinished by the allotted round interval time, winner may be chosen by selecting the user that used the least amount of time or who was leading as time expired (pg 4, par 38). Jokipii discloses that the user is provided with a multitude of gaming choices including board and tile games (pg 1, par 4-5). Jokipii discloses that the league administrator may also customize settings for the tournament games such as the time allowed to move (pg 3, par 36). Jokipii further discloses an electronic storage device (including databases) located on the server (*The Applicant describes the discarding-time storage means in reference to memory*). It is

also inherent for the game terminal to include RAM for storage. Jokipii also discloses the use of a computing device that may be a personal desktop, laptop, tablet computer, handheld computer, or mobile telephone (pg 3, par 30). It is also inherent that a computing device contains a computer-readable recording medium on which the game progress administering program for a game system and method is stored, such as RAM as discussed above. Jokipii discloses a setting a certain time limit for each move, as discussed above, but does not specifically disclose associating a discarding time with the rank of the player. Donn teaches that the time limit for each move or play by each player or team may be adjusted according to the skill level of the players or teams involved in the game. Donn further teaches more time being allowed for less skilled players and less time for players or teams having higher skills (pg 7, par 70). It is noted that Donn teaches a tile board game with a time that may be a kitchen timer or sand glass (pg 7, par 70). However, it would have been obvious to a person having ordinary skill in the art at the time of the invention to electronically generate the timer, since it has been held that broadly providing a mechanical or automatic means to replace a manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

It would have been obvious to a person having ordinary skill in the art at the time of the invention to have modified Jokipii in view of Donn to provide a greater challenge to more advanced players of the game.

Jokipii and Donn disclose the invention substantially as claimed except for extending the tile discarding time. Jokipii discloses a maximum amount of time per

move (pg 3, par 35), and that the game is played in real-time (pg 1, par 10). However, Walker teaches that players may request time extensions at any time during game play or purchase additional playing time (pg 9, par 111). Walker does not specifically disclose a limit on the number of time extensions, however the Examiner submits that the limit exists only such that a game or round does not continue indefinitely, but does not change the game outcome and is thusly design choice.

It would have been obvious to a person having ordinary skill in the art at the time of the invention to have modified Jokipii and Donn in view of Walker in order to allow players to purchase extra time to make a move, thereby increasing revenue for the gaming establishment and enjoyment for the player.

In reference to claim 2, Jokipii, Donn and Walker disclose the invention substantially as claimed. Jokipii further discloses setting the number of players to participate in the tournament (pg 3, par 35).

In reference to claim 3, Jokipii, Donn and Walker disclose the invention substantially as claimed. Jokipii further discloses setting the signup date and times, setting the date and time the tournament starts and time per round (pg 3, par 35).

In reference to claim 5, Jokipii, Donn and Walker disclose the invention substantially as claimed. Jokipii further discloses at least two types of tournament pairing systems, manual and automatic. In the manual pairings the administrator manually assigns game pairings using a tournament structure interface. The automatic pairing uses a randomizer to randomly pair participants or based on rankings or ratings (pg 4, par 37).

In reference to claim 6, Jokipii, Donn and Walker disclose the invention substantially as claimed. Jokipii further discloses that the tournament engine permits the league administrator to customize the length of each round. Rounds are considered complete when all the schedule games are complete or a tie for each round expires. When games are unfinished by the allotted round interval time, winner may be chosen by selecting the user that used the least amount of time or who was leading as time expired (pg 4, par 38).

In reference to claim 7, Jokipii, Donn and Walker disclose the invention substantially as claimed except for a computer player. Jokipii further discloses that the system also preferable monitors the progress of all the online games within each tournament, tallies the results and determines the winner(s) (pg 4, par 47). Donn teaches that the number of players is limited only by the number of different colors for the different sets of tiles (pg 2, par 14).

In reference to claim 10, Jokipii, Donn and Walker disclose the invention substantially as claimed. Donn teaches more time being allowed for less skilled players and less time for players or teams having higher skills (pg 7, par 70).

In reference to claims 14, 15, and 16, Jokipii, Donn and Walker disclose the invention substantially as claimed. Jokipii discloses that the online gaming system generally comprises one or more servers programmed and equipped to process data received from a plurality of user computing devices, including user profile data, which would include user rank and corresponding discard time (pg 2, par 27). Donn further

teaches more time being allowed for less skilled players and less time for players or teams having higher skills, as discussed above in claim 10.

**4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jokipii, Donn and Walker as applied above, and further in view of Stephenson (US 6,174,237).**

In reference to claim 4, Jokipii and Donn disclose the invention substantially as claimed except for a computer player. Stephenson teaches that the host computer has the ability to act as another player if a game required more than a single player that has not been matched (col 2, ln 19-21).

It would have been obvious to a person having ordinary skill in the art at the time of the invention to have modified Jokipii and Donn in view of Stephenson to include the feature of a computer operated opponent if all players are not matched with another human opponent.

***Response to Arguments***

5. Applicant's arguments have been fully considered but they are not persuasive.

With respect to the amendments to claims 1, 12 and 13, the Applicant asserts that "According to the disclosure of Walker et al., a time for playing a game as a whole can be extended if a player satisfies a predetermined condition such as a random event which occurs during the game, payment of fee for extension, and etc. In other words, the "time extension" disclosed in Walker et al. does not intend to extend a time limit



corresponding to a play or move in the game. It intends to extend a time limit for playing a game as a whole.”

The Examiner respectfully disagrees.

Firstly, Walker is relied upon to teach the concept of time extension within game play. Inasmuch, the Examiner does not acquiesce to the Applicant's point that Walker only extends time for a whole game. The Examiner would like to point out that the time extensions of the present invention also extend the time of the whole game. A game of this type is made up of a series of moves or plays. Subsequently, by extending the move or play within the game, extends the time of the game as a whole. As claimed, Walker's teaching of time extension meets the claim limitation rendering the limitation obvious.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcus D. Jones whose telephone number is (571)270-3773. The examiner can normally be reached on M-F 9-5 EST, Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John M. Hotaling can be reached on 571-272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marcus D. Jones/  
Examiner, Art Unit 3714

/John M Hotaling II/  
Primary Examiner, Art Unit 3714